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MF

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/910,497	07/19/01	EVANS	J 290397.0007

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IM22/1106

EXAMINER

HAMLIN, D

ART UNIT

PAPER NUMBER

1751

DATE MAILED: 11/06/01

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/910,497	Applicant(s) Evans et al.	
	Examiner Derrick G. Hamlin	Art Unit 1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Evaluations of level of ordinary skill in the art requires consideration of factors such as various prior art approaches employed, types of problems encountered in the art, rapidity with which innovations are made, sophistication of technology involved, educational background of those actively working in the field, commercial success, failure of others, and the inventor's educational level.

The "person having ordinary skill" in this art has the capability of understanding the scientific and engineering principles applicable to the claimed invention. The references of record in this case reasonably reflect this level of skill.

Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meyers et al. (US 5118434).

Meyers a composition based on an alkylene glycol, water, corrosion inhibitor and one or more polymeric additives, where the alkylene glycol may be ethylene or propylene glycol or mixtures thereof, from about 50-99 wt % of the composition (col. 2, lines 39-55). The reference further teaches that the corrosion inhibitor may be a metal

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tolyltriazoles, such as sodium tolyltriazoles, a triazole, such as sodium triazole, a nitrate, such as sodium nitrate or a molybdate such as sodium molybdate, in the amount of less than 20 wt % of the composition (col. 3, lines 2-11 and 19-21).

The reference teaches the addition of a polymeric material in up to 50%, which is not instantly claimed.

However, in the absence of showing unexpected results the composition of the reference containing the additional polymer material would read on the instantly claimed heat transfer fluid. Additionally, "up to 50%" would include anything in the 0-50% range and trace amounts. If it were found that polymer materials did adversely affect the composition, it would have to be shown that even a trace amount of the polymers would be detrimental. Therefore it would have been within the preview of the skilled artisan to create the instantly claimed heat transfer fluid, since Meyers discloses a composition containing 50-99 wt % of ethylene or propylene glycol or mixtures thereof, a corrosion inhibitor, such as sodium tolyltriazoles, sodium triazole, sodium nitrate or sodium molybdate.

Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maes et al. (US 5366651).

Maes discloses an antifreeze concentrate comprising a water-soluble liquid alcohol freezing point depressant and a corrosion inhibitor (col. 2, lines 62-65). The water-soluble liquid alcohol freezing point depressant may be water and an alkylene glycol, such as ethylene or propylene glycol or mixtures thereof (col. 3, line 65 - col. 4,

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line 8). The reference further teaches that the corrosion inhibitor may be a metal tolyltriazoles, a triazole, a nitrate or a molybdate (col. 4, lines 52-66).

The reference teaches the addition of a carboxylic acid material as part of the corrosion inhibitor and .05-5 % of an imidazole, which is not instantly claimed.

However, in the absence of showing unexpected results the composition of the reference containing the additional acid and imidazole material would read on the instantly claimed heat transfer fluid. If it were found that acid and imidazole materials did adversely affect the composition, it would have to be shown that claimed amount of the materials cited would be detrimental.

Therefore it would have been within the preview of the skilled artisan to create the instantly claimed heat transfer fluid, since Maes discloses a composition containing water, ethylene or propylene glycol or mixtures thereof, a corrosion inhibitor, such as tolyltriazoles, triazole, nitrate or molybdate.

Neither reference teaches the composition is an antidote for poisoning, however the compositions appear to be identical. Therefore, it is the examiners position that they would inherently possess the same properties, in the absence of showing superior or unexpected results.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

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1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-14 of co-pending Application No. 09/877,306. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: Both applications claim a heat transfer composition comprising (i) ethylene glycol and (ii) propylene glycol as antidote for ethylene glycol poisoning. The independent claim of the instantly claimed application recites the limitation of having a third component of a corrosion inhibitor. The co-pending application however, does not recite this limitation until claims, 4, 6, 10, 12 and 14. Still the scope of the claims would be identical.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schriber*, 397 F.2d 350, 158 USPQ 210 (CCPA

1958). See also MPEP § 804.

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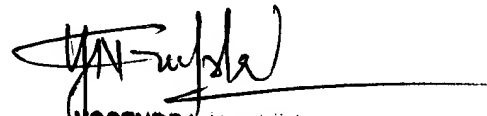
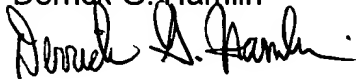
The remaining references listed on forms 892 and 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the rejection above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Derrick G. Hamlin whose telephone number is (703) 305-0590. The examiner can normally be reached on Monday-Thursday and alternating Fridays from 7:30 AM - 4:00 PM.

If reasonable attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Yogendra Gupta, can be reached on (703) 308-4708. The fax phone number for this Group is (703) 305-3600.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Derrick G. Hamlin



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